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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,944	10/04/2004	Martin Konemann	259560US0PCT	4976
22850	7590	07/14/2009	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.			ANTHONY, JOSEPH DAVID	
1940 DUKE STREET			ART UNIT	PAPER NUMBER
ALEXANDRIA, VA 22314			1796	
			NOTIFICATION DATE	DELIVERY MODE
			07/14/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/509,944	KONEMANN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Joseph D. Anthony	1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03/30/09 as an amendment.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,2 and 4-21 is/are pending in the application.

4a) Of the above claim(s) 6-8 and 14-18 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,2,4,5,9-13,19 and 20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

***FINAL REJECTION***

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 4-5, 9-13 and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 1 is deemed to be indefinite in regards to the limitation of: “on average from 0.05 to 100% of R<sup>1</sup>, R<sup>2</sup>, and R<sup>3</sup> present in the molecule are not hydrogen”. The claim is deemed to be indefinite because the Examiner is unable to see how a lower limit of “0.05” % is possible in light of formula (I). Assuming for argument sakes that in formula (I), **n** is equal to 1, then the total number of R<sup>1</sup>, R<sup>2</sup>, and R<sup>3</sup> groups would be 12 in the compound (i.e. 4 R<sup>1</sup> groups + 4 R<sup>2</sup> groups + 4 R<sup>3</sup> groups). Since it is impossible for any one of R<sup>1</sup>, R<sup>2</sup>, and R<sup>3</sup> groups to be less then a positive integer, this means that at a minimum at least 1 out of the 12 total R<sup>1</sup>, R<sup>2</sup>, and R<sup>3</sup> groups is NOT a hydrogen group. As such, the minimum calculate percentage of non-hydrogen groups in the molecule is approximately **8.33% if n is 1**.

If on the other hand, **n** is set to the maximum of 7, then a total of 30 R<sup>1</sup>, R<sup>2</sup>, and R<sup>3</sup> groups are present in the molecule of formula (I). Since it is impossible for any one of R<sup>1</sup>, R<sup>2</sup>, and R<sup>3</sup> groups to be less then a positive integer, this means that at a minimum at least 1 out of the 30 total R<sup>1</sup>, R<sup>2</sup>, and R<sup>3</sup> groups is NOT a hydrogen group. As such,

the minimum calculate percentage of non-hydrogen groups in the molecule is approximately **3.33% if n is 7.**

Likewise, claim 2 is indefinite because it depends on independent claim 1, and also because in regards to the limitation of: "on average from 0.01 to 12 of R<sup>1</sup>, R<sup>2</sup>, and R<sup>3</sup> present in the molecule are not hydrogen". Is applicant trying to claim an actual number of R<sup>1</sup>, R<sup>2</sup>, and R<sup>3</sup> groups, or did applicant forget to insert a '%' symbol?

Likewise, claim 20 is indefinite because it depends on independent claim 1, and also because in regards to the limitation of: "on average from 1 to 8 of R<sup>1</sup>, R<sup>2</sup>, and R<sup>3</sup> present in the molecule are not hydrogen". Is applicant trying to claim an actual number of R<sup>1</sup>, R<sup>2</sup>, and R<sup>3</sup> groups, or did applicant forget to insert a '%' symbol?

All other dependent claims are being rejected here because they are dependent on a rejected base claim and are thus indefinite.

### ***Response to Arguments***

Applicant's arguments filed 3/30/09 have been fully considered but are not persuasive to put the application in conditions for allowance for the reasons set forth above. Additional Examiner comments are set forth next.

Applicant's assertion that in the Office Action mailed 12/29/08 that claims 1-2, 4-5, 9-13 and 19-21 were rejected under 35 U.S.C. 112, second paragraph is incorrect only in regards to claim 21. Claim 21 was in fact withdrawn from consideration as being drawn to a non-elected invention since it is dependent on non-elected base claim 6. As

such, the claim status identifier of claim 21 as filed in the amendment of 3/30/09 is incorrect, and should be listed as --(Withdrawn)--.

The above rejection under 35 U.S.C. 112, second paragraph remains fully valid in spite of applicant's traversal. Applicant's main traversal statement is: *"If the scope of the claimed subject matter can be determined by one having ordinary skill in the art, a rejection using this form paragraph would not be appropriate"* (emphasis added; See MPEP § 706.03(d), Form Paragraph 7.34.01 Examiner Note).". Such a traversal does nothing to advance prosecution in the present application since the Examiner is one of ordinary skill in the art and the Examiner has set forth a detailed explanation of why the elected claims are in fact NOT clear to one having ordinary skill in the art. Applicant than goes on to cite certain sections was made under 35 U.S.C. 112, second paragraph NOT under 35 U.S.C. 112, first paragraph.

Nowhere in applicant's "REMARKS" does applicant make any attempt to actually refute the Examiner's made calculations of the minimum percentage of non-hydrogen groups in the listed cyclic compound of formula (I). The Examiner, in the above rejection, has clearly set forth that when "n" is 1 the minimum calculate percentage of non-hydrogen groups in the molecule is approximately **8.33%**. When "n" is 7 minimum calculate percentage of non-hydrogen groups in the molecule is approximately **3.33%**. As such, independent claim 1 is indefinite at least because it requires that: "on average from 0.05 to 100% of  $R^1$ ,  $R^2$  and  $R^3$  present in the molecule are not hydrogen". As shown above, applicant's said claim limitation is not possible because the percentage of non-hydrogen groups cannot be **less than approximately 3.33%**.

In regards to dependent claims 2 and 20, applicant did not effectively address the indefiniteness issues of these claims because applicant did not directly respond to the Examiner's statement of: "*Is applicant trying to claim an actual number of R<sup>1</sup>, R<sup>2</sup>, and R<sup>3</sup> groups, or did applicant forget to insert a '%' symbol?*".

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Examiner Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The centralized FAX

machine number is (571) 273-8300. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.

**/Joseph D. Anthony/  
Primary Patent Examiner  
Art Unit 1796  
7/7/09**